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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 09/781,615
Filing Date: February 12, 2001
Appellant(s): HATANAKA, IWAO

John A. Merecki
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 20 March 2006 appealing from the

Office action mailed 01 November 2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

Seacord et al., "A Survey of Black-Box Modernization Approaches for

Information Systems", IEEE, 2000, pp. 173-183.

Sintas, Tony, "Does Java pass by reference or pass by value?", Java World, May

2000, pp. 1-4.

"Dictionary of Computing", Fourth Edition, Oxford University Press, 1996, pp.

389.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 102

1.   The following is a quotation of the appropriate paragraphs of 35

U.S.C. 102 that form the basis for the rejections under this section made in

this Office action:

> A person shall be entitled to a patent unless –
>
> (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

2.   Claims 1, 3 and 5 are rejected under 35 U.S.C. 102(a) as being

anticipated by **Seacord** et al., "A Survey of Black-Box Modernization

Approaches for Information Systems".

Claim 1

Seacord disclosed a system for integrating a legacy application into a distributed data processing environment *(page 173, Abstract; page 180, section 3.3.3)*, the system comprising:

a legacy application located at a server coupled to a network *(page 180, section 3.3.3; page 180, left column, last paragraph, "application server, or EJB server"; page 180, right column, first paragraph, "wrapping a legacy system using EJB")*; and

an Enterprise JavaBean (EJB) wrapper surrounding the legacy application *(page 180, right column, first paragraph, "wrapping a legacy system using EJB")*, said EJB wrapper including an interface which allows for the distributed processing of logical components of the legacy application by a plurality of different processors over the network *(page 180, left column, last bullet, "Enterprise JavaBeans (EJB) is the Sun Microsystems solution for Java server-side computing"; page 181, figure 5)*, wherein the EJB interface allows for the distributed processing and the legacy application retains its conventional processing *(page 180, right column, first paragraph; wrapping legacy system using beans of EJB)*.

Claim 3

Seacord disclosed a method of integrating a legacy application into a distributed data processing environment *(page 173, Abstract)*, the steps of the method comprising:

analyzing a legacy application to separate its functions into logical components *(page 180, left column, last paragraph to right column, first paragraph)*;

distributing the logical components to different servers in the distributed data processing environment *(page 180, left column, last bulleted item, "Enterprise JavaBeans (EJB)" by definition EJB technology is distributed)*;

providing each logical component with an Enterprise JavaBean (EJB) interface *(page 180, right column, first paragraph)*; and

♦   providing an index to the components and the interface *(page 180, right column, second paragraph, "single point of contact")*.

Claim 5

Seacord disclosed the method of integrating a legacy application into a distributed data processing environment including the steps of Claim 3 and further including the step of using a shared library accessing a component bean and a library of export symbols *(page 180, right column, second paragraph; single access point to all other points, provides library/index of exports)*.

Claim Rejections - 35 USC § 103

3.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for

all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or
> described as set forth in section 102 of this title, if the differences between the subject
> matter sought to be patented and the prior art are such that the subject matter as a whole
> would have been obvious at the time the invention was made to a person having ordinary
> skill in the art to which said subject matter pertains. Patentability shall not be negatived by
> the manner in which the invention was made.

4.   Claims 2 and 4 are rejected under 35 U.S.C. 103(a) as being

unpatentable over **Seacord** et al., "A Survey of Black-Box Modernization

Approaches for Information Systems" in view of **Sintas**, Tony, "Does Java pass

by reference or pass by value?".

<u>Claim 2</u>

Seacord did not explicitly state the system for integrating a legacy application

of claim 1 wherein the system is configured such that data can be passed by

value rather than by reference. **Sintes** demonstrated that it was known at the

time of invention to provide structure to for "pass-by-value" in Java (first page,

first two paragraphs of the Answer section). It would have been obvious to one

of ordinary skill in the art at the time of invention to implement the Enterprise

JavaBean (EJB) wrapping system of **Seacord** with "pass-by-value" of the Java

langauge as found in **Sintes** teaching. This implementation would have been

obvious because one of ordinary skill in the art would be motivated by the

natural implementation of Java and the commonality of its various aspects

(EJB).

Claim 4

See claim 2 above.

5.   Claims 6 and 8 are rejected under 35 U.S.C. 103(a) as being

unpatentable over **Seacord** et al., "A Survey of Black-Box Modernization

Approaches for Information Systems" in view of "Dictionary of **Computing**".

Claims 6 and 8

The limitations of claims 6 and 8 correspond to the limitations of claims 3 and

5 and are rejected in the same manner. **Seacord** did not explicitly state a

program for carrying out the operations. **Computing** demonstrated that it was

known at the time of invention to make use of programs to produce a desired

behavior (page 389). It would have been obvious to one of ordinary skill in the

art at the time of invention to implement the legacy wrapping system of

Seacord with a program to carry out the operations/actions as found in

Computing's teaching. This implementation would have been obvious because

one of ordinary skill in the art would be motivated to automate actions in order

to reduce burden on the implementers of the action.

6.   Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over

Seacord et al., "A Survey of Black-Box Modernization Approaches for

Information Systems" in view of "Dictionary of **Computing**" in further view of

Sintas, Tony, "Does Java pass by reference or pass by value?".

Claim 7

In view of claim 6 and further in view of claim 4 above.

(10) Response to Argument

Appellant's arguments filed 20 March 2006 have been fully considered

but they are not persuasive. Appellant's primary arguments are: [1] **Seacord**

fails to disclose "distributed processing of logical components of the legacy

application by a plurality of different processors over the network"; [2] improper

use of inherency; and [3] **Seacord** fails to disclose "providing an index to the

components and the interface. These arguments are unpersuasive for the

following reasons.

In regard to Appellant's first primary argument, Appellant argues

Seacord fails to disclose "distributed processing of logical components of the

legacy application by a plurality of different processors over the network" (Brief:

page 3, second to last paragraph and throughout first half of page 4, regarding

independent claim 1). Referring to **Seacord** distributed processing is taught

(page 180, left column, third bulleted item, "Enterprise JavaBeans (EJB)"), a

componentized legacy application is taught (page 180, right column, first

paragraph, "wrapping a legacy system using EJB") and processing by a

plurality of different processors over a network is taught (page 180, third

bulleted item, "Enterprise JavaBeans (EJB)"; page 180, left column, last

paragraph, "EJB server"). Distributed processing by definition requires

multiple processors linked through a communication network (see Microsoft

Computer Dictionary). As Appellant must be aware, one of ordinary skill in the

art would recognize Enterprise JavaBeans are a distributed processing

technology. The reference to EJB alone provides distributed processing.

Further, distributed processing by a plurality of processors is additionally

proven by "server-side computing" (page 180, left column, third bulleted item)

and again by "a software component placed external to the EJB server" (page

180, right column, middle of second paragraph). Servers, software external to

servers and the clients using servers provide a plurality of processors and

therefore distributed processing as well.

Appellant states, "Nowhere in Seacord is there disclosure related to the

use of EJB component wrapping in a distributed processing environment"

(Brief: page 4, first sentence). Yet, **Seacord** clearly states "[t]he following

discussion uses EJB to illustrate component wrapping" (page 180, left column,

first paragraph under bulleted items). Appellant goes on to state, "Indeed,

Seacord provides no disclosure regarding how the beans provided by the EJB

server are processed by clients attached to the EJB server over a network"

(Brief: page 4, first paragraph). Again from **Seacord**, "Each bean encapsulates a piece of business logic. Enterprise JavaBeans are deployed within an application server, or EJB server, that provides the runtime environment for the bean and manages common services such as security, transactions, state management, resource pooling, _distributed naming_, automatic persistence, and _remote invocation_" (emphasis added; page 180, last paragraph left column). Further, Appellant states the claimed invention is "providing an Enterprise JavaBean (EJB) wrapper surrounding the legacy application" (Brief: page 2, Summary section) or in other words wrapping a legacy application/system using EJB wrappers. However, Appellant offers no explanation of how this differs from "wrapping a legacy system using EJB" (**Seacord**: page 180, right column, first sentence) other than reference to "distributed". This ignores **Seacord** figure 5, showing distributed processing, via multiple systems/processors at least one being the EJB server.

Appellant's flawed logic concludes **Seacord** is "completely silent with regard to the distributed processing of logical components by a plurality of processors over a network" (Brief: page 4, bottom of middle paragraph). Without doubt, a clear reading of **Seacord** proves this assertion to be false. The reference states several forms of plural processor distributed processing mechanisms, "distributed naming" and "remote invocation" (page 180, last paragraph left column, remote invocation also known as RPC).

In regard to Appellant's second primary argument, as to inherency (Brief: page 4, last paragraph), though the word "distributed" was not literally linked to EJB in the **Seacord** article, the use of EJB itself proves "distributed". This was explained previously, "**Seacord** clearly indicates using EJB to wrap logical components of legacy applications, it follows that the components and functionality of the legacy system are provided in a distributed manner" (Office Action mailed 19 May 2005, page 7, Remarks). Further explanation was offered to Appellant in the remarks of the action mailed 01 November 2005. Again, Appellant is reminded of the additional art cited as far back as 19 May 2005, **Johnson**, Mark "A Beginner's Guide to Enterprise JavaBeans" from Java World, October 1998. The summary of this article specifically and literally states Enterprise JavaBeans as distributed. The overwhelming evidence as constantly provided to Appellant by the Office, points to **Seacord**'s disclosure of distributed EJB components of a legacy application processed with a plurality of processors.

In regard to Appellant's third primary argument, Appellant asserts, without supporting remarks, "Seacord fails to teach or suggest 'providing an index to the components and the interface,' wherein the components are located in different servers" (page 5, first full paragraph). Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably

distinguishes them from the references. Despite Appellant, under the broadest

reasonable interpretation, the "single point of contact" discussion (**Seacord**:

page 180, right column, second paragraph) indicates Appellant's claimed

"providing an index to the components and the interface" (emphasis added).

An index or list of elements is merely a point of contact. Further, a plurality of

servers for the components is at least disclosed through **Seacord**'s use of EJB

and its distributed processing.

(11) Related Proceeding(s) Appendix

For the above reasons, it is believed that the rejections should be

sustained.

Respectfully submitted,

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